

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Joseph Schrader
Application No.: 09/903,973
Filed: July 12, 2001
Customer No.: 22971
Title: ENHANCED TELEVISION SERVICE

Attorney Docket No.: 164052.02
Group Art Unit: 2623
Examiner: Bui, Kieu Oanh T.
Confirmation Number: 9505

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This communication is in response to the Office Action dated April 6, 2007. Applicants provisionally elect Group II, claims 7-13, 16-18 and 29. The election is made with traverse.

The Office Action asserts that the present application is subject to restriction as follows:

I. Claims 1-6, drawn to an enhanced broadcast television service including means for linking broadcast TV programming with the related content in accordance with an identifier, classified in class 725, subclass 40.

II. Claims 7-13, 16-18, and 29, drawn to a method for presenting enhanced broadcast TV programming including receiving a schedule and receiving enhanced broadcast Internet Protocol (IP) data including an event identifier associated with the IP data, classified in class 725, subclass 51 (for external online resource).

III. Claims 14-15, 19, and 28, drawn to a system, a computer program product and a method for representing visual indicators and displaying of Internet data in a second designated portion of the display while broadcast TV signals are displayed in a first designated portion of the display, classified in class 725, subclass 43 (displaying with separate window, panel or screen).

IV. Claims 21-27, drawn to a method for presenting a tunable alert on a television

Type of Response: Response
Application Number: 09/903,973
Attorney Docket Number: 164052.02
Filing Date: July 12, 2001

receiver concerning of an event associated with TV programming, classified in class 725, subclass 50 or 58.

V. Claims 30-40, drawn to a method of providing enhanced TV services related to sports score data and displaying a channel responsive to the unique event identifier associated with the sports score data string, classified in class 725, subclass 56 (to channel specific).

The Office Action asserts on page 3 that the inventions of Groups I-V are related as combination and subcombination. The Office Action also asserts that the inventions are distinct because the combination as claimed (i.e., invention of Group I) does not require the particulars of the subcombination as claimed (i.e., inventions of Groups II-V), and each subcombination has separate utility.

Even assuming, for argument's sake, that these assertions are correct, the Examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden if restriction was not required. To support a requirement for restriction between combination and subcombination inventions, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search (see MPEP 806.05(c)). Thus, the Examiner must show by appropriate explanation one of the following (see MPEP 808.02):

(A) **Separate classification thereof:** This shows that each invention has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each invention can be shown to have formed a separate subject for inventive effort when the examiner can show a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for

Type of Response: Response
Application Number: 09/903,973
Attorney Docket Number: 164052.02
Filing Date: July 12, 2001

one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries), a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions (see MPEP 808.02).

Applicants submit that the Office Action fails to sufficiently satisfy any one of the criteria A, B or C above for establishing serious burden on the Examiner. For example, the Office Action indicates that the inventions of Groups I-V are classified in the same class (class 725). Therefore, no separate classification has been established. Additionally, the Office Action fails to establish that the inventions have a separate status in the art by showing that each invention has formed a separate subject for inventive effort.

Furthermore, the Office Action fails to establish that different fields of search would be required. On the contrary, applicants submit that the inventions of Groups I-V are sufficiently related that a thorough search for the subject matter of any one group of inventions would encompass a search for the subject matter of the remaining groups. For example, the inventions of Groups I-V are all related to using Internet protocol data in conjunction with broadcast television programming to provide an enhanced viewing experience to viewers (see specification, page 1, lines 3-6). The Office Action on page 4 provides only conclusory statements in support of its assertion that there would be a serious burden if restriction was not required because the inventions require a different field of search.

Applicants submit that the search and examination of the entire application could be made without serious burden. In fact, Examiner Timothy M. Murphy of Art Unit 2611 previously performed a search of the prior art for the inventions of Groups I-V, as indicated in

Type of Response: Response
Application Number: 09/903,973
Attorney Docket Number: 164052.02
Filing Date: July 12, 2001

the Office Action mailed on November 21, 2003.

If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions (see MPEP 803). Therefore, applicants respectfully request that the requirement for restriction be withdrawn, and all of the claims of the present application be examined, in order to avoid unnecessary delay and expense to the applicants and duplicative examination by the Patent Office.

Type of Response: Response
Application Number: 09/903,973
Attorney Docket Number: 164052.02
Filing Date: July 12, 2001

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Applicants submit that the present application is in condition for allowance and request favorable action in the form of a Notice of Allowance. If this response is not considered timely filed and if a request for an extension of time is otherwise absent, applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,
Microsoft Corporation

Date: May 4, 2007

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CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being electronically deposited with the USPTO via EFS-Web on the date shown below:

May 4, 2007
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/Kate Marochkina/
Signature

Kate Marochkina
Type or Print Name

Type of Response: Response
Application Number: 09/903,973
Attorney Docket Number: 164052.02
Filing Date: July 12, 2001